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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,365	06/17/2008	James Bain	BAI-01/SYN.3282.US	3199
23508	7590	04/28/2010	EXAMINER	
LUNDEEN & LUNDEEN, PLLC			WRIGHT, GIOVANNA COLLINS	
2710 Louisiana				
HOUSTON, TX 77006			ART UNIT	PAPER NUMBER
			3672	
			NOTIFICATION DATE	DELIVERY MODE
			04/28/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/598,365	Applicant(s) BAIN, JAMES	
	Examiner GIOVANNA C. WRIGHT	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14, 28 and 30 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 18, 19, 22-27 and 29 is/are rejected.
- 7) ☒ Claim(s) 17, 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/13/10 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15-16, 18-19, 22-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wardley 20020189863.

Referring to claims 15 and 29, Wardley discloses (see fig. 1) a shoe for use on the end of a work string after drilling a well bore, the shoe comprising a generally cylindrical body having a first end (at 3) adapted for connection to the end of the work string (as broadly claimed a casing is tubing in that it is in the form of a tube) and a second end (at 5) including a nose portion; the nose portion including a rounded head distal to the body for advancement through the well bore and a plurality of blades (4)

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extending from the head towards the body; the body having thereupon a reaming portion (8) located behind the nose portion wherein the reaming portion comprises a plurality of discrete raised members to ream the bore.

Referring to claim 16, Wardley discloses the blades (4) include a cutting surface (at 6) to assist in breaking through bridges.

Referring to claim 18, Wardley discloses wherein the raised members (8) are elongate and continuous.

Referring to claim 22, Wardley discloses wherein the nose portion (5) includes one or more ports (7).

Referring to claim 23, Wardley discloses a gauge portion (at 9) located furthest from the nose portion.

Referring to claims 24-26, Wardley discloses the gauge portion comprises a plurality of elongate blades (9) arranged helically along the body.

Referring to claim 27, Wardley discloses the shoe is constructed from a combination of relatively hard and relatively soft materials (paragraph 0050).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wardley '863 in view of Mabry 6808019.

Referring to claim 19, Wardley does not disclose the members are in the shape of a teardrop. Mabry teaches (see figs. 3-4) tear drop shaped members Mabry teaches the shape and mounting of the raised members helps to improve the flow (see col. 7, lines 16-25). As it would be advantageous to improve the flow around the reamer, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the reaming members disclosed by Wardley to be teardrop shaped in view of the teachings of Mabry.

Allowable Subject Matter

5. Claims 1-14, 28 and 30 are allowed.
6. Claims 17,20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 3/17/10 have been fully considered but they are not persuasive. Referring to claim 15, the applicant argues that the Wardley reference does not disclose a tubing shoe for use after boring or drilling. The phrases of "for use on the end of a work string after drilling a well bore" ,"for connection to the end of the work string" and "for advancement through the well bore" are considered intended use. A

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recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Yanush, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); In re Finsterwalder, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); Ex parte Masham, 2 USPQ2d 1647 (BdPatApp & Inter 1987). Therefore, the intended use phrases such as "for use on the end of a work string after drilling a well bore" , "for connection to the end of the work string" and "for advancement through the well bore" are not given any patentable weight.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIOVANNA C. WRIGHT whose telephone number is (571)272-7027. The examiner can normally be reached on 7:30-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Giovanna C. Wright/
Primary Examiner, Art Unit 3672